

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Yuan Verra, et al

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For : BONE MARROW ASPIRATION TROCAR

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: Office of PCT Legal administration

REQUEST FOR RECONSIDERATION

Sir:

In response to the decision dated 9 January 2007, in the above-referenced matter, the undersigned hereby requests reconsideration of the decision refusing to accept the Declaration submitted on 14 November 2006.

The PCT legal examiner refused the Declaration improperly, using a standard that extends beyond the requirements of 37 CFR 1.42.

The PCT legal examiner refused to accept the Declaration because it did not “unambiguously” indicate that the three sole heirs who signed the Declaration were “all” the heirs, engaging in improper speculation to refuse the Declaration.

No section of the Manual of Patent Examining Procedure (MPEP), nor of 37 C.F.R. 1.42 use the terms “all the heirs” or the “sole heirs”, nor is there a requirement that this be stated in the inventor declaration: MPEP 409.01(a) “Application may be made by the heirs of the inventor....MPEP 409.01(d) “Hence, the person having authority corresponding to that of executor ...for example, the heirs in the Federal Republic of Germany...”.

There is no requirement that the Declaration be totally unambiguous, by law or rule, and it is instead sufficient according to the law and rule to clearly state that the

signatories are “the heirs” of the deceased inventor. Moreover, such a Declaration, signed by the heirs, will be accepted at face value. Proof of authorization is not required. According to MPEP 409.01(d), it is up to those signing to be sure that they are acting with proper authority, and so long as they are properly identified by name, address and citizenship, no more is required. By their signatures, the heirs are representing that they are authorized to proceed on behalf of the deceased inventor.

Equity is not concerned with refinements of representative description. Gratz’s Executors v. Cohen, 11 How. at page 20, 13 L.Ed. 579, (“Too much importance has, in our view, been attached to the payment being to her, and not repeating the words ‘as executrix,’ and the recovery of one judgment being against the other executors, without repeating their titles. These mere descriptions, inserted or omitted, cannot, however, in chancery, change the essence of a transaction, when they had nothing to receive, or grant, or account for, except as executors of Joseph Simon...”.) cited in Harris & Schafer, Inc. v. Curtiss Aerocar Co., 69 F.2d 264 (5th Cir. 1934) in regards to the authority to assign a patent by an executrix. Here, adjusting the grammar to suit the PCT legal examiner would not change the essence of the transaction, that is, the heirs have signed the declaration on behalf of the deceased inventor; no more is required.

In this case, the three heirs were identified by declarations submitted at the international stage. (see enclosed) Their names were also listed as the heirs on International Publication no. WO2004/110281 A2. The Declaration submitted and refused by the PCT Legal Examiner also goes beyond the bare minimum requirement of identifying the signatories as “the heirs”, by clarifying that they are the three sole heirs. The use of one of three, two of three and three of three of the deceased inventor’s sole heirs reasonably conveys that there are only three “sole” heirs, and that all three have signed the declaration, the speculation of the PCT legal examiner notwithstanding. The Declaration thus satisfies the requirement of 37 CFR 1.42 and MPEP 409.01(d) and must be accepted.

Given that the Declaration was signed by the three sole heirs of the deceased inventor, and this has been reasonably clear since the original Declarations were submitted in the international stage, it is arbitrary and capricious to refuse to accept the Declaration signed by the same identified three sole heirs.

Reconsideration and acceptance of the Declaration is respectfully requested.

_____/WJS/
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